

S/N 10/624,660
Attorney Ref. No. 659-1143
Client Ref. No. 19,226

REMARKS

In the Office Action mailed March 27, 2007, the Examiner withdrew claims 2-7, 9-16 and 28-33 from consideration. The Examiner then rejected claims 1 and 8 under 35 USC 102(e) as being anticipated by one of US Pub. 2004/0060648 to Thorson or US Pub. No. 2004/0122397 to Morman and under 35 USC 103 as being obvious over US Pub. No. 2002/0151863 A1 to Otsubo. Applicants respectfully disagree and submit that the claims as presented herein are patentable over the cited references.

Written Statement As to Substance of Interview and Comments About Restriction/Election:

The Examiner mailed an Election/Restriction requirement on December 6, 2006, wherein the Examiner identified ten (10) species and instructed Applicants to “elect a *single* disclosed species” (Office Action at 3) (emphasis added). In response, Applicants elected Species G and stated that claims 1-8, 10-16 and 28-33 were either generic with respect to, or read on, Species G (Response to Restriction Requirement file January 8, 2007). Notwithstanding Applicants’ election, and the fact that the Examiner previously examined claims 1-16 and 28-31 *on the merits*, apparently without undue burden, the Examiner considered only claims 1 and 8 in the most recent Office Action.

In response, Applicants initiated a telephone interview with the Examiner on April 11, 2007 to discuss the Examiner’s decision not to examine claims 2-7, 10-16 and 28-33. In particular, Applicants explained that every one of claims 2-7, 10-16 and 28-33 reads on the elected Species G. During the interview, the Examiner did not substantively dispute that the noted claims did in fact read on Species G, but instead invited Applicants to traverse this

decision in writing (*see also* Interview Summary mailed April 16, 2007). Accordingly, Applicants respectfully request that the Examiner reconsider her decision to examine only claims 1 and 8, and instead examine all of the claims that are generic with respect to, or read on, elected Species G.

As explained by Applicants during the interview, it is important to remember that “the scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim), or a claim may include two or more of the disclosed embodiments within the breadth and scope of the claim (and thus be designated a generic or genus claim)” (MPEP 806.04(e)). One must be careful, however, not to fall into the trap of designating claims as species (*see, e.g.*, Office Action at 2-3, describing each Species as “disclosed” or “exemplified” by one or more claims). The long established rule is that “*claims are never species*” (MPEP 806.04(e) (emphasis in original)). Rather, species are different embodiments (*Id.*). In the present case, claims 1-8, 10-16 and 28-33 each read on, or are generic with respect to, elected Species G. Indeed, claim 9 is the *only* claim that does not read on the elected Species G.

During the interview, Applicants further discussed with the Examiner the possibility that perhaps she intended to designate five (5) categories of species, wherein Applicants could elect one species from each category (e.g., (1) species A and B; (2) species C and D; (3) species E and F; (4) species G and H; and (5) species I and J). Indeed, whether a crotch member is connected to a body side or garment side of a body panel web (Species G and H) has nothing to do with, and are not different “species” with respect to, the shape of a cutout (Species C and D). As such, claims that specifically target, for example, the subject matter of Species C and D are not limited in scope with respect to Species G and H.

In the present case, however, the Examiner expressly requested Applicants to elect a “single” designated species from the list of ten (A-J). Applicants should not now be punished by way of limited examination when clearly a great number of claims (all but claim 9) withdrawn by the Examiner read on the elected species G. To the extent the Examiner desires to restructure the election/restriction requirement as directed to five categories of species, Applicants respectfully request a new Office Action with an opportunity to respond thereto.

Finally, Applicants respectfully submit that the Examiner has refused to examine certain claims that are generic with respect to *all* of the designated species. For example and without limitation, Applicants submit that at least independent claim 10 is generic with respect to all of the designated species. Applicants respectfully submit that a new Office Action should be issued on this basis alone.

Remarks About the 35 USC 102 Rejections:

Applicants have amended claim 1 to recite that “said cutout *extends from at least one of said first and second cut edges toward a respective one of said first and second outer edges,*” and further “connecting a crotch member to each of said rear and front body panel webs, wherein said crotch member covers an *entirety* of said cutout.”

As asserted by the Examiner, Thorson discloses a “cutout” of waste material 42 (Office Action at 3; Thorson at FIG. 2). As disclosed in Thorson, however, the panel webs 76, 78 are shifted in the longitudinal direction prior to the crotch member 50 being applied to the body panel webs such that the peaks 54, 154 of the webs are aligned (Thorson at para. 70; FIGS. 3 and 4). As shown in FIG. 2 of Thorson, the only portion of the “cutout” of waste

material 42 that “extends from” one, or even both, of the cut edges 84, 86 “toward” a respective one of the outer edges 80, 82, as recited in claim 1, is positioned along the respective valleys 56, 156 of Thorson (*Id.*). As disclosed by Thorson, however, the crotch member 50 is fastened to the webs 76, 78 over the “peaks,” not the valleys (FIG. 3; para. 73). As such, Thorson does not disclose or suggest that the crotch member “covers an *entirety* of said cutout,” since the cutout that extends from the cut edge toward the outer edge lies at least partially in the *uncovered* valleys 56, 156 of the web. Because Thorson does not disclose or suggest all of the recitations of claim 1, Applicants respectfully submit that claim 1 should be passed to allowance.

Applicants further submit that Morman suffers the same deficiencies of Thorson (*see* Morman at paras. 64 and 65). Accordingly, claims 1 and 8 also are allowable over Morman.

Remarks About the 35 USC 103 Rejections:

As set forth in the prior response, independent claim 1 recites “forming a cutout in said web and thereby *removing a portion of said body panel material from said web*, . . . wherein said removed portion of said body panel material *does not form any part of said front and rear body panel webs.*” In contrast, Otsubo discloses making a single longitudinal cut to form the first and second half webs 81, 82, *without any material being removed* (Otsubo at para. 28; FIGS. 6 and 9). The cut edges form curved convex edges (Otsubo at paras. 7 and 24, FIG. 5). After the webs 81, 82 are separated, a pad 4 is connected, such that the tops 42 of leg holes 41 substantially coincide with the respective tops 44 of the thighs 45 b of a baby 43 (Otsubo at para. 24; FIG. 5). In this way, Otsubo emphasizes that the mating convex curves of the front and rear body panels 2, 3 provide a purported optimal fit of the diaper (Otsubo at

paras. 7 and 24). Any additional “cutout” would diverge from this construction. As such, even if the Examiner considers the trough (edge adjacent elastic 77) of web 81 to be a “cutout,” the material removed forms the crest (edge adjacent elastic 78) of web 82 and thereby forms part of the body panel webs (see, e.g., FIG. 6 (the same goes for trough 79 of web 82 and crest 76 of web 81)).

Moreover, the pad of Otsubo is secured to the *bodyside* surface of the front and rear body panels 2, 3 (Otsubo at para. 21, FIG. 1). As such, there is no need for a cutout in the either panel of Otsubo to provide access to the pad 4. For this additional reason, there is no suggestion to form a cutout in the rear panel in Otsubo. In this respect it is important to remember that it is *not necessary whether the claims recite such attachment configurations*, but rather simply whether there is a lack of motivation to combine the references based on their teachings. Moreover, there is not even any motivation to “try” and switch the placement, since attaching the pad to the garment side would decrease the surface area of the pad exposed to the user.

In this same vein, Otsubo discloses the importance of continuously applying elastic members 73 and 74 so as to draw substantially sinusoidal curves, with the members 73 and 74 being “symmetric about a center line c of the web” (Otsubo at para. 27; FIG. 6). In this way, the web may be cut into first and second half webs 81, 82 along line d, with one elastic member 72 associated with one leg-hole, and the other leg elastic member 73 associated with the other leg-hole (Otsubo at para. 28, FIG. 6). As such, Otsubo teaches against forming any other cutouts, which could interrupt the sinusoidal curvature of the elastic members, and prohibit the ability to cut the web between the elastic members so as to form the desired profiles that conform to the thigh of the user (Otsubo at paras. 24-28; FIG. 6). As set forth in MPEP

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2143.01, since “the proposed modification or combination of [Otsubo] would change the principle of operation of the [Otsubo] invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie obvious.*” *Citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (. . . “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.”). For all of these reasons, there is no suggestion to modify Otsubo as suggested by the Examiner.

Moreover, as acknowledged by the Examiner, Otsubo fails to recite all of the limitations of claim 1. Instead, the Examiner turns to the Applicants own specification for support that it would have been obvious to modify Otsubo (Office Action at 6). Such an analysis is improper.

Knowledge of applicant’s disclosure must be put aside in reaching [the] determination [of obviousness]. The tendency to resort to ‘hindsight’ based on applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. (MPEP 2142)

Moreover, the Examiner’s analysis cuts the other way in any event. Specifically, the Examiner refers to the Background of Applicants’ application when asserting that “Applicant’s specification teaches that removing and discarding cutout material is wasteful” (Office Action at 6). As such, the Background of Applicants’ specification would not further teach one of ordinary skill in the art to modify Otsubo by removing any material, but would in fact teach exactly the opposite.

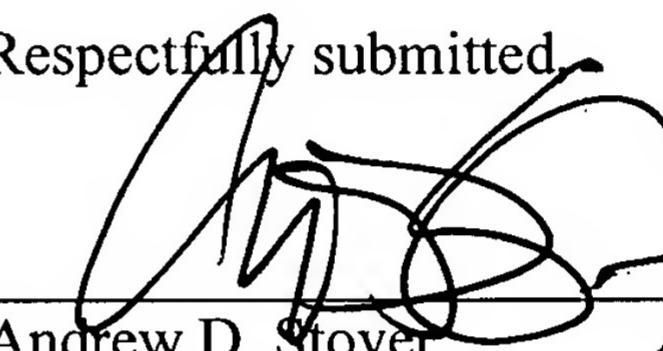
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Conclusion

Applicants respectfully request reconsideration and examination of claims 2-7, 10-16 and 28-33. At the same time, Applicants respectfully submit, for at least the reasons set forth above, that claims 1-8, 10-16 and 28-33 should be passed to allowance. Any questions concerning this amendment should be directed to the undersigned attorney at (312) 321-4713.

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Respectfully submitted,


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